## REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed March 24, 2004. A telephone conference was conducted between the Examiner and supervising Examiner on May 17, 2004. The discussion involved on subject matter of the arguments set forth below.

In the Office Action, claims 1-2, 5, 23-24, 27, 45-46, 49-51 and 54 were rejected under 35 U.S.C. §102(b) as being anticipated by Wasilewski (U.S. Patent No. 6,157,719). In addition, claims 3-4, 6-9, 16-19, 22, 25-26, 28-31, 36, 38-41, 44, 47-48, 52-53, and 55-58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wasilewski in view of Muratani (U.S. Patent No. 6,061,451). Applicants respectfully traverse the rejection.

As the Examiner is aware, Wasilewski describes a system for limiting access to broadcast information. A CATV company or satellite television company provides its subscribers with information from a number of services. For example, the History Channel is a "service" that provides television programs about history. Each program provided by the particular service, such as the History Channel for example, is considered to be an "instance" for that service. *See Col. 4, lines 18-28 of Wasilewski.*

The instance is encrypted before being broadcasted to a large number of set top boxes ($113_0$-$113_N$). The encrypted instance (105) contains instance data (109), the encrypted information making up the program, and entitlement control messages (107). The entitlement control messages "ECM" (107) contain information needed to decrypt the encrypted instance data (109). *See Col. 4, lines 28-40 of Wasilewski.* The contents of the ECM (107) are changed every few seconds, or more frequently. *See Col. 4, lines 39-40 of Wasilewski.* Based on our review of Wasilewski (Col. 4, lines 52-55; Fig. 1), the ECM is not stored with the scrambled program. Rather, the ECM is used in combination with the previously stored authorization information (121) to produce a control word (117), which is used to decrypt the instance data (109) of the encrypted instance (105).

### I. §102(E) REJECTION

In the Office Action, claims 1-2, 5, 23-24, 27, 45-46, 49-51 and 54 were rejected under 35 U.S.C. §102(b) as being anticipated by Wasilewski. Applicant points out that the rejection cannot be a §102(b) rejection because the subject application was filed prior to the issuance of Wasilewski. The rejection will be treated as a §102(e) rejection. Applicant respectfully traverses the outstanding §102(e) rejection in its entirely because a *prima facie* case of anticipation has not been established.

As the Examiner is aware, a claim is anticipated only if each and every element as set forth in the claim is described, either expressly or inherently, in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d 1051, 1053 (Fed. Cir. 1987); *See also MPEP § 2131.* Herein, Wasilewski does not describe each and every element set forth in claims 1-2, 5, 23-24, 27, 45-46, 49-51 and 54.

According to page 2 of the Office Action, it is alleged that Wasilewski discloses the following limitations:

1) each program provided by a particular channel is an "instance" of that service; and
2) ECM is an access requirement.

With accordance with independent claims 1, 23, 45 and 50, the limitation of the "scrambled program" has been interpreted as an instance (e.g., a program for particular channel). *See Page 2 of the Office Action.* Moreover, the limitation of receiving a plurality of access requirements allegedly constitutes ECMs. *See Page 2 of the Office Action.* However, Wasilewski does not disclose the storage of the scrambled program (encrypted instance) and the ECM (considered to be the "access requirement"). In contrast, authorization information (121) from an enhancement management mode (EMM) is stored in the set-top box, not the ECM (107). The ECM (107) is extracted from the encrypted instance (105) and routed to the control word generator (119), which produces a control word (117) used to decrypt the instance data (109) of the encrypted instance (105).

In light of the foregoing, Applicant respectfully requests the Examiner to reconsider and withdraw the §102(e) rejection. In the event that the Examiner disagrees that the claims are in condition for allowance, Applicant respectfully requests the Examiner to address the limitations associated with each independent claim since these claims may differ slightly in wording and claim breadth.

II. §103(A) REJECTION

In the Office Action, claims 3-4, 6-9, 16-19, 22, 25-26, 28-31, 36, 38-41, 44, 47-48, 52-53, and 55-58 were rejected under 35 U.S.C. §103(a) as being unpatentable over Wasilewski in view of Muratani. Applicants respectfully traverse the rejection because a *prima facie* case of obviousness has not been established.

When evaluating a claim for determining obviousness, *all* limitations of the claim must be evaluated. *In re Fine*, 873 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988)(Emphasis added). Herein, neither Wasilewski nor Muratani, alone or in combination, suggest every limitation set forth in the above-identified claims. For instance, none of these references describes or suggests "[means for] storing the scrambled program data and the selected at least one access requirement" as set forth in independent claims 6, 16, 28, 38, 55 and 58.

Moreover, the Office Action is devoid of any support for many of the limitations set forth in the independent claims, such as for example:

Claim 6: None of these references describes or suggests "re-scrambling said digital content in a descrambled format to provide a second output"; and

"outputting said first output including said digital content in a descrambled format and a second output including said digital content in a re-scrambled format."

Claim 16: None of these references describes or suggests "outputting said first output including said digital content in a descrambled format"; and "outputting a second output including said digital content in a scrambled format."

Claim 28: None of these references describes or suggests "means for re-scrambling said digital content in a descrambled format to provide a second output including said digital content in a re-scrambled format"; and "means for outputting said first output including said digital content in a descrambled format and a second output including said digital content in a re-scrambled format."

Claim 38: None of these references describes or suggests "means for outputting said first output including said digital content in a descrambled format; means for outputting a second output including said digital content in a scrambled format."

Claim 55: None of these references describes or suggests "re-scrambling said digital content in a descrambled format to provide a second output including said digital content in a re-scrambled format"; and "outputting said first output including said digital content in a descrambled format and a second output including said digital content in a re-scrambled format."

Claim 58: None of these references describes or suggests "outputting said first output including said digital content in a descrambled format; outputting a second output including said digital content in a scrambled format."

Applicant respectfully requests the Examiner to reconsider and withdraw the outstanding §103(a) rejection.

***Conclusion***

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 5/24/2004

By _____

William W. Schaal
Reg. No. 39,018
Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

---

***CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)***

*I hereby certify that this correspondence is, on the date shown below, being:*

**MAILING**

☒ *deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450.*

Date: 5/24/2004

**FACSIMILE**

☐ *transmitted by facsimile to the Patent and Trademark Office.*

*Susan McFarlanes* 5/24/2004
*Susan McFarlanes* *Date*